

## **Remarks**

The examiner objected to the title as not being descriptive and required a new title. Applicants amended the title as the examiner suggested.

The examiner rejected claims 1-24 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,617,674 in view of U.S. Publication 2002/0000239 to Sachdev, *et al.* (Sachdev) because 6,617,674 discloses substantial features of claims 1-3 and 11 except removing all or a portion of the patterned film using an etching solution. The examiner further argues that Sachdev discloses removing elastomeric silicone adhesives using an etching solution. The examiner concludes it would have been obvious to combine 6,617,674 and Sachdev to remove silicone for the purpose of rework.

The examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2002/0158317 in view of Sachdev. The examiner argues that 2002/0158317 discloses a method comprising steps (i), (ii), (iii), (iv), and (v) of claim 1 of this invention. The examiner admits that 2002/0158317 fails to disclose: step (vi) removing all or a portion of the product of step (iv) using an etching solution in claim 1. The examiner admits that 2002/0158317 fails to disclose where the removing step is carried out using an etching solution comprising an organic solvent and a base. The examiner further argues that Sachdev discloses removing elastomeric silicone adhesive deposits using an etching solution comprising an organic solvent and a base. The examiner admits that Sachdev fails to disclose where the etching solution contains no more than 25 % water. The examiner concludes it would have been obvious to the person having ordinary skill in the art at the time of the invention.

Applicants wish to bring to the examiner's attention that U.S. Publication 2002/0158317 and U.S. Patent 6,617,674 both stem from the same patent application. U.S. Publication 2002/0158317 is the prior publication that matured into U.S. Patent 6,617,674, and applicants

hereinafter refer to U.S. Publication 2002/0158317 and U.S. Patent 6,617,674 collectively as the Becker references.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143. Even where the combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper MPEP §2143.01. The level of skill in the art cannot be relied upon to provide the suggestion to combine references MPEP §2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination MPEP §2143.01. A statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references MPEP §2143.01.

A conclusion of obviousness based upon a reconstruction taking into account knowledge that was not within the level of ordinary skill in the art at the time the claimed invention was made is improper hindsight, for example, knowledge gleaned only from applicant's disclosure MPEP §2145 (X)(A).

That 'obvious to try' is not the standard under § 103 has been directed mainly at two

kinds of error. In some cases, what would have been ‘obvious to try’ would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. . . . In others, what was ‘obvious to try’ was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it MPEP §2145 (X)(B).

The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success MPEP §2143.02. At least some degree of predictability is required MPEP §2143.02. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness MPEP §2143.02. Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made MPEP §2143.02.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art MPEP §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art MPEP §2143.03. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious MPEP §2143.03.

With respect to claim 1, the Becker references do not teach or suggest any method for removing all or a portion of the patterned film, therefore, the Becker references lack step (vi) of claim 1 and step (v) of claim 2. Furthermore, Sachdev does not disclose removal of a patterned film by immersion at ambient temperature for 1 to 25 minutes. All of the examples of Sachdev were performed with heating (p. 5, paragraphs [0063] to [0067]). Therefore, Sachdev does not cure the defects of the Becker references. For these reasons, not all of the criteria for establishing a *prima facie* case of obviousness have been established. Therefore, the applicants request

withdrawal of both the obviousness type double patenting rejection and the rejection under 35 U.S.C. §103(a) and allowance of all claims.

The initial burden is on the examiner to provide some suggestion of the desirability for doing what the inventor has done. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper MPEP §2142.

If the examiner believes there is factual support for rejecting the claimed invention under 35 U.S.C. §103, the examiner **must** then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant MPEP §2142.

This reply is being submitted within the period for response to the outstanding office action. Although the applicants believe in good faith that no extensions of time are needed, the applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,  
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